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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,216	07/05/2000	Roland D. Tai	1624.001A	4737

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EXAMINER

LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/610,216

Applicant(s)

TAI, ROLAND D.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-42, 45-49, 52 and 53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-42, 45-49, 52 and 53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 40-42, 45-49, 52 and 53 have been examined. Application 09/610,216 has a filing date 07/05/2000 and is a continuation of 09026289 (02/19/1998)

Response to Amendment

2. In response to Non Final Rejection filed 01/07/2005, the Applicant filed an Amendment on 06/30/2005, which amended claims 40, 46, 47 and 53. Applicant's amendment overcame the Section 112 rejection.

Claim Objections

3. Claim 40 is objected to because of the following informalities: Claim 40 recites in line 12 "the **identify** of the specific customer" when it should recite "the **identity** of the specific customer". Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40-42, 45-49, 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US 5,995,942) in view of Day (US 6,484,146).

As per claims 40 and 47, Smith teaches:

A system for providing promotions comprising:

a printed promotion carrier which carries information corresponding to a plurality of promotions *for sale of a product* (see Smith figure 6), the promotion carrier having a machine readable code thereon which identifies the promotion carrier *and a respective specific customer identifier corresponding to the identified promotion carrier, the respective specific customer identifier corresponding to a specific customer pre-selected to receive the printed promotion carrier* (see Smith column 5, lines 22-30; figure 6, item "barcode"), each promotion being associated with a product, each product having a machine readable product code (see Smith figure 6, column 5, lines 24-26; column 8, lines 1-10) *and the printed promotion carrier being presented by the specific customer when used for each of the plurality of promotions for sale of the product* (see Smith column 7, lines 50-67).

a reading device capable of reading the machine readable code and machine readable product codes, and configured to provide a data signal bearing information indicative of the identity of the promotion carrier, *the identity of the specific customer* and the identity of a plurality of selected products (see Smith column 5, lines 24-26; column 7, lines 55-62; column 8, lines 1-19); and

a computer facility capable of receiving the data signal and configured to determine if the promotion carrier contains a redeemable promotion for a product of the plurality of selected products (see Smith column 8, lines 1-19),

Smith fails to teach:

wherein the data signal contains a promotion carrier data signal bearing information indicative of an identity of the promotion carrier presented to the reading

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device, and the computer facility determines if there are valid promotions contained on the promotion carrier, *by determining* if a promotion on the promotion carrier has already been presented in a completed transaction, and identifying the promotion as a valid promotion if it has not already been presented in a completed transaction. However, Day teaches detecting and avoiding double couponing (see column 6, line 55 – column 7, line 10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to identify promotions as valid if not already presented in Smith in order to allow a household to participate in the reward offer while preventing double couponing (using the same offer more than once).

As per claims 41 and 48, Smith teaches:

The system of claim 40, wherein the machine readable code is a bar code and the reading device is a bar code reading device (see Smith figure 6).

As per claims 42 and 49, Smith teaches:

The system of claim 40, wherein the data signal contains a product data signal bearing information indicative of an identity of the plurality of selected products and the computer facility determines a purchase price of the selected products (see Smith column 3, lines 15-25; column 8, lines 1-20).

As per claims 45 and 52, Smith teaches:

The system of claim 42, further comprising a check out terminal associated with the reading device and configured to receive payment for the selected products, wherein the computer facility is configured to generate a subtotal purchase price for the selected products, subtract valid promotions from the subtotal purchase price to

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generate a customer bill, and provide the customer bill to the check out terminal (see Smith column 3, lines 17-25).

As per claims 46 and 53, Smith teaches:

The system of claim 40, wherein

when the computer facility receives the data signal bearing information indicative of the identity of the promotion carrier for a completed transaction, data regarding all products comprising the completed transaction are stored (see Smith column 8, lines 9-19);

the system further comprising a data analysis facility which is configured to analyze the data signal and the data regarding all products comprising the completed transaction to determine predetermined aspects of the use of the promotion carrier (see Smith column 8, lines 9-20) including identities of each product of the completed transaction and at least one of the total charged amount for the completed transaction exceeding a predetermined value (see Smith column 3, lines 17-22), each product of the completed transaction providing a profit exceeding a predetermined money amount and each product of the completed transaction providing a profit exceeding a predetermined percentage (see Smith column 8, lines 9-20; "purchase volume of a particular product"). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that if Smith determines the purchase totals to reflect savings (see Smith column 3, lines 19-22) and identifies purchase volume of a particular product, then Smith would use said identification to determine promotions that are producing profits (i.e. profits exceeding a predetermined volume or percentage) and

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would adjust the targeting of said promotions to customers based upon said determination. Smith would determine products that are not selling (i.e. low volume) and would target incentives to customers to entice customers to purchase said low selling products.

Response to Arguments

5. Applicant's arguments filed 06/30/2005 have been fully considered but they are not persuasive. The Applicant argues that Smith cannot be combined with Day to teach a reusable printed promotion carrier because Smith cancel a printed promotion carrier once a scanner scans said promotion carrier. The Examiner answers that the Applicant is arguing about features that are not stated in the claims. Applicant's amendment canceled the limitation reusable printed promotion carrier, the claims steps do not recite any particular steps that lead to the promotion being reusable.

The Applicant argues that the reference Day cannot be used to teach the limitation "the computer facility determines if a detected promotion on the promotion carrier has already been presented in a completed transaction, and identifies the detected promotion as a valid promotion if it has not already been presented in a completed transaction" because in Day the customer's shopping list of special offers is never presented to a reading device for reading a machine readable code on the shopping list associated with each product having a special product offer. The Examiner answers that Day teaches in column 6, lines 56-67 a system that verifies if a coupon is presented twice to avoid double couponing. Therefore, Day identifies the detected

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promotion (i.e. coupon) as a valid promotion if it has not already been presented in a completed transaction (i.e. trying to use a coupon more than once).

The Applicant argues that Day does not teach "a promotion carrier which bears a plurality of offers for sale of a plurality of promotions...and the printed promotion carrier being presented by the specific customer when used for each of the plurality of promotions for sale of the product". The Examiner answers that Smith teaches said limitation in column 5, lines 21-31 and figure 6. Objection to the claims and the Section 112 rejection have been withdrawn.

Conclusion

6. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-6:00.

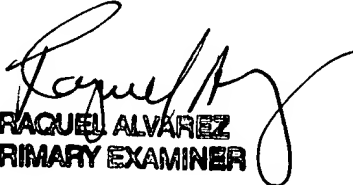
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The Examiner's Right fax number is 571-273-6720.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
September 10, 2005


RAQUEL ALVAREZ
PRIMARY EXAMINER